

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of:

TRAN

Application No.: 09/842,599

Filed: 4/25/2001

For: SYSTEMS AND METHODS FOR
TRADING INTELLECTUAL
PROPERTY

Examiner: Weisberger, Richard

Art Unit: 3624

REPLY BRIEF

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Appellant offers this Reply in response to the Examiner's Answer.

I. CLAIMS 1 AND 16-34 COMPLY WITH SECTION 112

The Examiner's reply failed to note the point raised in the appeal that claim 1's "rating information" is discussed in the paragraph around page 12, line 30 and thus is supported by the specification.

As to claim 17, page 3, line 10 shows that the parties can list and search for applications that are near abandonment. Although the language of "about to be abandoned" was revised to address a prior Section 112 rejection, one skilled in the art would know that applications are about to be abandoned covers applications that are within a predetermined period from abandonment.

Claims 16 and 18-20 were originally filed with the application and are *per se* supported.

As to claim 21, page 3, lines 25-30 and page 9, lines 21-24 teach to one skilled in the art that the PIM permits sellers to list assets for sale, buyers to bid on assets of interest and users to browse through listed items in a fully-automated, topically-arranged, intuitive and easy-to-use online service.

As to claim 22, page 3 lines 26-28 shows one skilled in the art that the PIM provides real time and interactive auctions that allows bidders place bids in real time and compete with other bidders using the Internet.

As to claim 23, page 3, lines 28-30 shows one skilled in the art that the PIM allows customer bids to be automatically increased up to a maximum amount so bids can be raised and auctions won even when bidders are away from their computers.

As to claim 24, page 4, lines 3-9 shows one skilled in the art that the PIM provides the user with access to a social network.

As to claim 25, page 4, lines 3-9 shows one skilled in the art that the PIM provides the user with access to a network of IP lawyers for assistance in finalizing the applications, specialists for trading IP, venture capitalists and financiers.

As to claim 26, page 4 lines 14-15 shows one skilled in the art that the PIM displays advertisements for a predetermined period of time.

As to claim 27, page 17, line 10 and page 1 line 23 show one skilled in the art that the PIM allows an inventor to file a patent application with a patent office.

As to claim 28, page 17 line 10 shows that the PIM allows an inventor to file a patent application.

As to claim 29 page 3 line 19 and page 4 lines 7-10 show that the PIM automatically updates the user on any new IP in the user's areas of interest.

As to claim 30 page 6 line 27 and page 7 lines 22-31 show that the PIM provides an appraisal of the IP.

As to claim 31 page 8 lines 15-28 shows that the PIM provides escrow to facilitate an IP transaction.

As to claim 32, page 12 lines 26-31 shows that the PIM provides a virtual showroom which displays the IPs offered for sale and enables a potential purchaser or customer to view the IP asset, view rating information regarding the IP asset or place a bid to purchase the IP asset.

As to claim 33, page 13 lines 1-6 shows that the PIM accesses one or more search engines that continuously search the web and identify information that is of interest to the user.

In sum, the claims, as viewed by one skilled in the art, are supported under the first paragraph of Section 112. Applicant notes that the Examiner is taking a very narrow interpretation here, and then in the Section 103 rejection, takes the inconsistent official notice that each construct is well known.

In sum, all claims are supported by the Specification. Withdrawal of the Section 112 rejection is requested.

II. CLAIMS 1 AND 16-34 ARE PATENTABLE OVER RIODAN.

Claims 1 and 16-20 were originally rejected under 35 U.S.C. 102(a) as anticipated by Riodan, NY Times article. The Final Office Action raised a Section 103 Rejection on all claims over Riodan. The Office Action took official notice that each module of claims 1, 17 and 21-34 are known in the art.

Applicant respectfully traverses the rejection. Here, the rejection is improper since the prior art reference relied upon by the examiner in a § 103 rejection does not contain every element recited in the claim in as complete detail as is contained in the claim and arranged as recited in the claim. Nowhere in Riodan does it show the claimed specifics of a system to support trading of intellectual property (IP) with a user interface displayed by the processor to accept a request to trade an IP asset; a user interface displayed by the processor to store information on the IP asset including rating information; and a database coupled to the user interface and to the processor to store data associated with one or more IP assets, the database supporting the trading of the IP asset. Withdrawal of the rejection is requested.

The Examiner notes in his answer that the official notice that “ratings modules” are well known in the art of electronic assets markets. In fact this “well known” argument is used repeatedly in rejecting the other claims below. Applicant has previously requested that support be provided or the rejection be withdrawn.

In the instant case, the Examiner has not provided any rationale or evidence in the reference proving that Riodan shows the processor and the database and the rating information for trading IP assets. Withdrawal of all rejections is requested.

Here, the suggestion arises from hindsight as taught by the instant application.
Per MPEP 706.02(j): Contents of a 35 U.S.C. 103 Rejection:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP Section 2143 - Section 2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP Section 2144 - Section 2144.09 for examples of reasoning supporting obviousness rejections.

As discussed above, there is no suggestion to modify Riordan to arrive at the invention as claimed. There is no reasonable expectation of success since Riordan does not even address IP rating information. Finally, Riordan, does not teach or suggest all the claim limitations in the independent claims as well as each dependent claims. Since the teaching or suggestion to make the claimed combination and the reasonable expectation of success is not found in Riordan, there is an inference that it came from Applicants' disclosure. Thus, Riordan cannot render obvious the independent claim and those claims dependent therefrom.

Moreover, dependent claims are allowable since Riordan does not show the specifics as recited in the dependent claims. The Examiner relied on Riordan's page 2, 4th paragraph which states that

In addition to patents, the site will trade in technology packages that might include engineering expertise or advice on regulatory compliance. Mr. du Pont

says companies and inventors can also use yet2.com to sell inventions long before they receive patents. "Because we're not only about patents, it's possible to post very recently discovered technologies," he said. "DuPont will be posting over 100 recently discovered technologies, all of which are patent-pending."

As for claim 16, Riordan fails to show the claimed online platform for selling and buying patentable ideas or pending patent applications through a user interface displayed by the processor to accept a request to trade an IP asset; a user interface displayed by the processor to store information on the IP asset including rating information; and a database coupled to the user interface and to the processor to store data associated with one or more IP assets, the database supporting the trading of the IP asset.

As for claim 17, Riordan fails to show the claimed parties can list and search for applications that are within a predetermined period from abandonment. Riordan's 4th paragraph on page 2 is completely silent on this.

As for claim 18, Riordan fails to show claim 1 where the network is the Internet and wherein clients access the system using a browser. Riordan's 4th paragraph on page 2 is completely silent on this.

As for claim 19, Riordan fails to show the claimed a patent information management (PIM) system to display information for a user to manage the user's IP and to communicate with other users relating to the IP. Riordan's 4th paragraph on page 2 is completely silent on this.

As for claim 20, Riordan fails to show that the PIM provides information on pending activities relating to an IP asset and wherein the user drills down to get additional information on the IP asset. Riordan's 4th paragraph on page 2 is completely silent on this.

As for claim 21, Riordan fails to show that the PIM permits sellers to list assets for sale, buyers to bid on assets of interest and users to browse through listed items in a fully-automated, topically-arranged, intuitive and easy-to-use online service. Riordan's 4th paragraph on page 2 is completely silent on this.

As for claim 22, Riordan fails to show that the PIM provides real time and interactive auctions that allows bidders place bids in real time and compete with other bidders using the Internet.

As for claim 23, Riordan fails to show that the PIM allows customer bids to be automatically increased up to a maximum amount so bids can be raised and auctions won even when bidders are away from their computers. Riordan's 4th paragraph on page 2 is completely silent on this.

As for claim 24, Riordan fails to show that the PIM provides the user with access to a social network. Riordan is devoid of this aspect.

As for claim 25, Riordan fails to show that the PIM provides the user with access to a network of IP lawyers for assistance in finalizing the applications, specialists for trading IP, venture capitalists and financiers. Riordan's 4th paragraph on page 2 is completely silent on this.

As for claim 26, Riordan fails to show that the PIM displays advertisements for a predetermined period of time. Riordan's 4th paragraph on page 2 is completely silent on this.

As for claim 27, Riordan fails to show that the PIM allows an inventor to file a patent application with a patent office. Riordan's 4th paragraph on page 2 is completely silent on this.

As for claim 28, Riordan fails to show that the PIM allows an inventor to file a patent application. Riordan's 4th paragraph on page 2 is completely silent on this.

As for claim 29, Riordan fails to show that the PIM automatically updates the user on any new IP in the user's areas of interest. Riordan's 4th paragraph on page 2 is completely silent on this.

As for claim 30, Riordan fails to show that the PIM provides an appraisal of the IP. Riordan's 4th paragraph on page 2 is completely silent on this.

As for claim 31, Riordan fails to show that the PIM provides escrow to facilitate an IP transaction. Riordan's 4th paragraph on page 2 is completely silent on this.

As for claim 32, Riordan fails to show that the PIM provides a virtual showroom which displays the IPs offered for sale and enables a potential purchaser or customer to view the IP asset, view rating information regarding the IP asset or place a bid to purchase the IP asset. Riordan's 4th paragraph on page 2 is completely silent on this.

As for claim 33, Riordan fails to show that the PIM accesses one or more search engines that continuously search the web and identify information that is of interest to the user. Riordan's 4th paragraph on page 2 is completely silent on this.

As for claim 34, Riordan fails to show that the PIM supports user-generated IP content. Riordan's 4th paragraph on page 2 is completely silent on this.

As to claims 22-34, the Examiner simply took official notice that each element is "well known in the field of electronic auction markets." However, if it is that well known, citations should have been made. Applicant submits that Examiner has not fulfilled his burden to show obviousness.

Appellant points out that the Examiner bears the initial burden of factually establishing and supporting any *prima facie* conclusion of obviousness. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976); M.P.E.P. § 2142. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness. *Id.* In the instant case, the Examiner has not pointed to any evidence in Riordan, or how knowledge of those skilled in the art, provide a suggestion or motivation to modify the reference teaching so as to produce the claimed invention of independent claim 1. See *In re Zurko*, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001) ([I]n a determination of patentability the Board cannot simply reach conclusions based on its understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings).

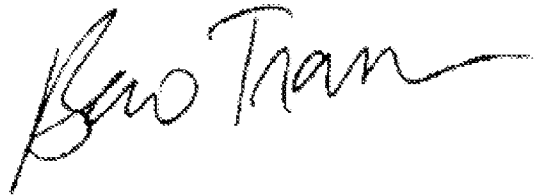
Under *Vaeck*, absent any evidence of a cited suggestion or reasonable motivation in the Marsh reference, or knowledge of those skilled in the art, for modifying Riordan to arrive at claims 1 and those dependent therefrom, *prima facie* obviousness of these claims has not been established. As such, it is respectfully requested that the § 103(a) rejection of all claims be withdrawn and the claims be allowed.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 408-528-7490.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Bao Tran". The signature is fluid and cursive, with a long horizontal stroke extending to the right.

Bao Tran

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